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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,197	03/27/2001	Satomi Nishikawa	P278064	3685

909 7590 07/16/2002

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EXAMINER

LOEB, BRONWEN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 07/16/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/806,197

Applicant(s)

NISHIKAWA ET AL.

Examiner

Bronwen M. Loeb

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-12 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. §§ 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1 and 3-10, drawn to a promoter of SEQ ID No. 1 and the first method of use for the promoter.

Group II, claim(s) 1, 3-7, 9 and 10, drawn to a promoter of SEQ ID No. 7.

Group III, claim(s) 8, drawn to a first method of use for the promoter of SEQ ID No. 7.

Group IV, claim(s) 11, drawn to a second method of use for the promoter of SEQ ID NO. 1.

Group V, claim(s) 11, drawn to a second method of use for the promoter of SEQ ID NO. 7.

Group VI, claim(s) 2, 4, 7, 9 and 10, drawn to a terminator of SEQ ID No.

- 2.

Group VII, claim(s) 8, drawn to a first method of use for the terminator of SEQ ID No. 2.

Group VIII, claim(s) 12, drawn to a second method of use for the terminator of SEQ ID No. 2.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I has the special technical feature not shared by the remaining groups of a promoter for plant cells having the sequence of SEQ ID No. 1. Group II has the special technical feature not shared by the remaining groups of a promoter for plant cells having the sequence of SEQ ID No. 7. Group III has the special technical feature not shared by the remaining groups of first method of use of the promoter having the sequence of SEQ ID No. 7. Group IV has the special technical feature not shared by the remaining groups of a second method of use for the promoter of SEQ ID No. 1. Group V has the special technical feature not shared by the remaining groups of a second method of use for the promoter of SEQ ID No. 7. Group VI has the special technical feature not shared by the remaining groups of a terminator of SEQ ID No. 2. Group VII has the special technical feature not shared by the remaining groups of a first method of use for the terminator of SEQ ID No. 2. Group VIII has the special technical feature not shared by the remaining groups of a second method of use for the terminator of SEQ ID No. 2.

Applicant is reminded that, in accordance with 37 CFR 1.475(d), if multiple products, processes of manufacture, or uses are claimed, the first invention of the

category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims. Furthermore, only the first invention may have a combination of categories, such as a product, a product of manufacturing the product and a process for using the product. See 37 CFR 1.475(b).

2. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone numbers for the Group are (703) 308-4242 and (703) 305-3014. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bronwen M. Loeb whose telephone number is (703) 605-1197. The examiner can normally be reached on Monday through Friday, from 10:00 AM to 6:30 PM. A phone message left at this number will be responded to as soon as possible (usually no later than the next business day after receipt by the examiner).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel, can be reached on (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to Tracey Johnson, Patent Analyst whose telephone number is (703) 305-2982.

Bronwen M. Loeb, Ph.D.
Patent Examiner
Art Unit 1636

July 11, 2002



REMY YUCEL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600